

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Charles D. Hoke et al.

Serial No.: 10/736,090

Examiner: P. Vu

Filing Date: 12-15-2003

Group Art Unit: 2871

Title: LIQUID CRYSTAL CELL THAT RESISTS DEGRADATION FROM EXPOSURE TO RADIATION

COMMISSIONER FOR PATENTS
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER FOR RESPONSE/AMENDMENT

Sir:

Transmitted herewith is/are the following in the above-identified application:

- (X) Response/Amendment () Petition to extend time to respond
() New fee as calculated below () Supplemental Declaration
(X) No additional fee (Address envelope to "Mail stop Non-Fee Amendments")
() Other: (fee \$)

CLAIMS AS AMENDED BY OTHER THAN A SMALL ENTITY						
(1) FOR	(2) CLAIMS REMAINING AFTER AMENDMENT	(3) NUMBER EXTRA	(4) HIGHEST NUMBER PREVIOUSLY PAID FOR	(5) PRESENT EXTRA	(6) RATE	(7) ADDITIONAL FEES
TOTAL CLAIMS	44	MINUS	44	= 0	X \$18	\$ 0
INDEP. CLAIMS	5	MINUS	5	= 0	X \$88	\$ 0
[] FIRST PRESENTATION OF A MULTIPLE DEPENDENT CLAIM					+ \$300	\$ 0
EXTENSION FEE	1ST MONTH \$110.00	2ND MONTH \$430.00	3RD MONTH \$980.00	4TH MONTH \$1530.00		\$ 0
OTHER FEES						\$
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						\$ 0

Charge \$ 0 to Deposit Account 50-1078. At any time during the pendency of this application, please charge any fees required or credit any overpayment to Deposit Account 50-1078 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 50-1078 under 37 CFR 1.16, 1.17, 1.19, 1.20 and 1.21. A duplicate copy of this sheet is enclosed.

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Date of Deposit 05-06-2005

I hereby certify that this is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.

By Joy H. Perigo
Typed Name: Joy H. Perigo

Respectfully submitted,

Charles D. Hoke et al.

By

Michael A. Papalas

Attorney/Agent for Applicant(s)
Reg. No. 40,381

Date: 05-06-2005



Agilent Technologies, Inc.
Legal Department, DL429
Intellectual Property Administration
P.O. Box 7599
Loveland, Colorado 80537-0599

Docket No.: 10040070-1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Charles D. Hoke et al.

Application No.: 10/736,090

Confirmation No.: 3282

Filed: December 15, 2003

Art Unit: 2871

For: LIQUID CRYSTAL CELL THAT RESISTS
DEGRADATION FROM EXPOSURE TO
RADIATION

Examiner: P. Vu

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Examiner's Restriction Requirement mailed April 6, 2005, Applicants hereby elect Group I, which includes claims 2 and 7-18 as defined by the Restriction Requirement, for further prosecution. Applicants also note that claims 1 and 44 are defined by the Restriction Requirement as generic, and thus will be prosecuted along with the claims of Group I.

The election is being made WITH TRAVERSE. Applicants respectfully request reconsideration and withdrawal of the restriction requirement in light of the arguments set forth below.

The grouping of the claims is not understood by the Applicants. On page 2 of the Action, the Examiner states that Groups I-III are combinations and Groups IV-VI are subcombinations. However, on page 3 of the Action, the Examiner states that Group IV is a

combination of Groups I and II, Group V is a combination of Groups I and III, and Group VI is a combination of Groups II and III. This statement seems to indicate that Groups I-III are being considered subcombinations and Groups IV-VI are being considered combinations. Applicants respectfully request clarification as to this issue.

This Restriction Requirement is improper. The Restriction Requirement groups the claims into 6 groups, and states that Groups I-III are combinations and Groups IV-VI are subcombinations. Applicants note that under M.P.E.P. § 806.05(c) two-way distinctness must be shown to establish that combination/subcombination inventions are distinct. The Action has stated provided that each subcombination (of Groups IV-VI) has a separate utility from the combination (Groups I-III) such as a means for reducing contaminants of a liquid crystal cell. However, Applicants note that in the next six lines of the Action, the Examiner states that Groups I-III all include means for reducing contaminants. Thus, according to the Restriction Requirement, the combination and the subcombination have the same utility. Consequently, two-way distinctness has not been shown.

The Restriction Requirement also presents a series of evidence claims as support for the distinctness of the different groups. For example, “[c]laim 2 presents evidence that Group I is patentably distinct from Groups II-VI and can operate without the particulars of Groups II-VI”. Firstly, this is an improper use of an evidence claim, as evidence claims are used to show that the combination does not rely upon the specific details of the subcombination for patentability, see M.P.E.P. § 806.05(c)III. Thus, it does not show distinctness between different combinations nor between different subcombinations. Moreover, Applicants note that the subject matter of each of the cited evidence claims is similar to the subject matter in the claims of other Groups. For example, claim 2 (Group I) is similar that of claim 5 (Group V) and claim 31 (Group IV). Therefore, the cited evidence claims are not sufficient to show distinctness between the different groups.

Applicants believe that a reasonable search for the invention of Group I would overlap with the search for Groups II-VI, as all of the groups have common limitations such as a LCD cell, a top plate, a substrate, and liquid crystal material. Furthermore, several claims in each of the groups have similar subject matter with claims in other groups. For example, claim 16 (Group I), claim 28 (Group II), claim 39 (Group III) have similar subject

matter. Also, claim 4 (Group III) and claim 42 (Group V) have similar subject matter. Thus, Applicants believe that there is no serious burden on the Examiner so as to require restriction between Groups I-VI.

Applicants note that specific reasons and/or examples with regards to the burden of the different groups have not been provided, which is contrary to the requirements of M.P.E.P. § 803, wherein the M.P.E.P. states that Examiners must provide reasons or examples to support their conclusions. The claims of Groups I-VI are each concerned with LCDs, and thus do not contain divergent subject matter. Applicants believe that Groups I-VI would more than likely be classified in the same class, and Applicants believe that a reasonable search for each of the inventions in Groups I-VI would include common subclasses. Therefore, Applicants believe that the inventions of Groups I-VI do not place a serious burden on the Examiner in searching each of the inventions, and that restriction between Groups I-VI is improper.

Applicant believes no fee is due with this response. However, if a fee is due, please charge Deposit Account No. 50-1078, under Order No. 10040070-1, from which the undersigned is authorized to draw.

Dated: May 6, 2005

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Dated: May 6, 2005

Signature: 

Joy H. Pengo

Respectfully submitted,

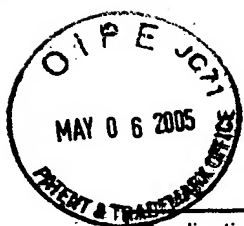
By 

Michael A. Papalas

Registration No.: 40,381

Attorney for Applicant

(214) 855-8186



Application No.: 10/736,090

Attorney Docket No.: 10040070-1

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on May 6, 2005
Date

Signature

Joy H. Perigo

Typed or printed name of person signing Certificate

Registration Number, if applicable

(214) 855-8171

Telephone Number

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